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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,190	07/11/2001	Jean-Baptiste Dumas Milne Edwards	G-036US03DIV	9722

23557 7590 12/22/2003

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EXAMINER

DESAI, ANAND U

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/903,190

### Applicant(s)

EDWARDS ET AL.

### Examiner

Anand U Desai

### Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1,2,3. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of claims 9-13 in Election response dated October 31, 2003 is acknowledged. Applicant's amendment to withdraw Claims 1-8 and 14-20 and cancel Claims 9-13 are acknowledged. Claims 21-36 are under examination.

### ***Priority***

2. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(e) and 120. The priority date is August 10, 1998 claiming priority to provisional application serial number 60/096,116.

### ***Information Disclosure Statement***

3. Reference WO 96/34981 was not considered because an English translation was not submitted in the parent patent application U.S. Serial No. 09/247,155. Also, the Examiner has not initialed PTO-1449, where the references cited are not found with the parent patent application or the instant application.

### ***Specification***

4. The use of the trademark has been noted throughout this application. For example, page 18, line 8 the trademark "RNASIN", page 25, line 28 the trademark "ACA34 GEL", and the various databases on page 66, lines 19-31. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 27-30, 35, and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 27-30, the phrase "of any" makes the claim indefinite. The phrase "The polypeptide of claim" would be definite. Claims 35 and 36 are included in the rejection for depending on the rejected claims.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 31-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are directed to polypeptides having at least 75% to 99% identity, and allelic variants of SEQ ID NO:97, which is described as belonging to a C-type lectin family. The claims are also directed to methods of making and isolating the various polypeptides. To satisfy the written description requirement, the specification must describe the invention in sufficient

Art Unit: 1653

detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. The specification does not describe the structure, that is amino acids in the various polypeptides that can be altered without affecting the function of a specific polypeptide. An adequate representation of species requires that the species which are described and recognized in the art as representative of the entire genus. What constitutes a “representative number” is an inverse function of the predictability in the art is question. Cambi et al. show that difference in structural domains predict different functions, and also that some type II C-type lectin receptors functions are still unknown (see Table 1 and Figure 2, Cambi, A. and Figdor, C. Curr Opin Cell Biol. 15(5):539-546 Oct 2003), so for one to be in possession of the claimed invention, the inventor would have to know the functional consequences of structural alterations. Thus due to the limited predictability in the art, a skilled artisan would not find adequate support for claims 31-36 in the specification.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 31-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Ashkenazi et al. (Effective filing date=November 5, 1997). Ashkenazi et al. teach a polypeptide having 99.4% identity to the polypeptide disclosed as SEQ ID NO:97 (U.S. application 2003/0082546, see figure 306; current application, claims 31-34). Ashkenazi et al. also teach the method of making

Art Unit: 1653

a recombinant polypeptide using an expression vector in a host cell and recovering the recombinant polypeptide from a cell culture (U.S. application 2003/0082546, claim 11; current application, claims 35, and 36).

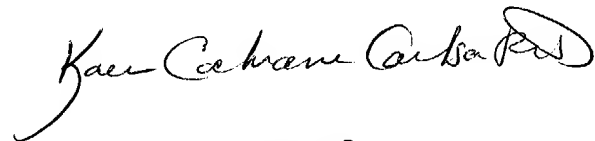
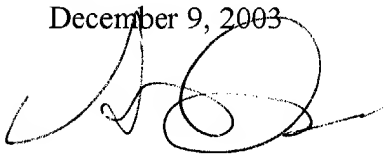
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anand U Desai whose telephone number is (703) 305-4443. The examiner can normally be reached on Monday - Friday 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (703) 308-2923. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0198.

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December 9, 2003



KAREN COCHRANE CARLSON, PH.D  
PRIMARY EXAMINER